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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,698	10/17/2000	Guy Nathan	871-95	1505

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NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER

NGUYEN, DAT

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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10/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/688,698	Applicant(s) NATHAN ET AL.	
	Examiner Dat T. Nguyen	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12 and 15-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/12/2007 has been entered.

Response to Amendment

This office action is responsive to the amendments filed on 07/12/2007 in which applicant amends claims 12 and 19 and responds to claim rejections. Claims 12 and 15-23 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (US 5,848,398) in view of Johnny Rockets Name That Tune and further in view of Tom & Liz's Name That Tune and Winksy et al (US 5,739,451).

Martin et al. discloses a method and apparatus for managing a plurality of computer jukeboxes at different locations from a remote central station. The remote central station

Art Unit: 3714

maintains a host computer having a master library of songs stored in a bulk storage unit and each "jukebox" maintains a subset song library of the master library of songs. Each jukebox is updated with new songs and menus by simply downloading the data via a transmission link. Furthermore, in one embodiment, the computer jukebox is associated with an electronic game. Martin et al. additionally discloses:

Regarding Claims 12 and 19:

- a remote server (central management system (11)) and at least one terminal (jukebox #1..jukebox #N (13)) operable to communicate with the server over a communications network, wherein the terminal (jukebox) includes an audio system (127, 129, and 131) for playing in connection with a game (electronic game) at least a portion of a musical recording (Abstract, Figures 1, 4A, 4B, 5, Column 1, line 66-Column 2, line 51, and Column 3, line 15-Column 4, line 40, and Column 9, lines 38-42);
- the terminal is a jukebox system that includes a storage device (93) that stores a library of musical recordings (91) that can be played in full on the terminal for a fee (Figure 5), and further wherein the library of musical recordings can be automatically updated with additional musical recordings through communication with the server, thereby defining a customized library of musical recordings on the jukebox system (Abstract, Figure 1, 4, 5, Column 1, line 66-Column 2, line 51, Column 3, line 15-Column 4, line 40, Column 4, lines 58-63, Column 5, lines 40-57, Column 6, lines 8-18, Column 6, lines 45-52, and Column 7, lines 39-57).

Martin et al. seems to lack explicitly disclosing:

Regarding Claims 12 and 19:

Art Unit: 3714

- a display that displays information in the form of a question and suggests multiple choice answers to the question, wherein the question relates to the portion of musical recording that has been played, a user interface that enables a user to select an answer from the displayed multiple choice answers, and a scorer for recording the answer selected by the user and determining if the answer corresponds to a correct answer; and
- further wherein the jukebox system is operable to dynamically select the musical recording for the game from the customized library of musical recordings and to dynamically generate the question for the game based on the contents of the customized library of musical recordings stored on the jukebox system.

Regarding Claim 15:

- the terminal sends information to the server regarding how the user performed during the game.

Johnny Rockets Name That Tune teaches of a Name that Tune game that is played over a network, such as, the Internet. Johnny Rockets Name That Tune and Martin et al. are analogous art because each are computerized game systems that are associated with music played on jukeboxes. Johnny Rockets Name That Tune, however, seems to lack explicitly disclosing playing a song for a fee.

Johnny Rockets Name That Tune teaches:

Regarding Claims 12 and 19:

- a display that displays information in the form of a question and suggests multiple choice answers to the question (questions 1-5), wherein the question relates to the portion of musical recording that has been played, a user interface (Web

Art Unit: 3714

page and player personal computer mouse and keyboard) that enables a user to select an answer from the displayed multiple choice answers, and a scorer for recording the answer selected by the user and determining if the answer corresponds to a correct answer (How Did I Do?); and

Regarding Claims 15 and 19:

- the terminal sends information to the server regarding how the user performed during the game (How Did I Do?).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Johnny Rockets Name That Tune game in Martin et al. One would be motivated to combine Martin et al. with Johnny Rockets Name That Tune because the Johnny Rockets Name That Tune game is entertaining and would provide an additional source of profit for Martin's computer jukebox system when in the game mode.

Regarding claims 12 and 19, Martin et al. also seems to lack explicitly disclosing:

Updating of the customized libraries of musical recordings stored on the jukebox system with musical recordings stored on the server for the needs of the game. Tom and Liz's Name That Tune is a music trivia game that updates weekly (pp 1 of 10). The music for the game must be the same for all systems on the network. Martin et al. also discloses the ability of the central server to automatically transmit songs to the jukeboxes as needed. Martin et al. and Tom and Liz's Name That Tune are analogous art because both are computerized games played over a network associated with music. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the weekly updating of the song library with the jukebox networking system of Martin et al. One would be motivated to combine Martin et al. with Tom and Liz's Name That Tune

Art Unit: 3714

because it the prospect of competing with other plays would raise user interest in the jukebox system. Furthermore, the combination of Martin et al. with the game of Tom and Liz's Name That Tune would require for the songs to be present in the jukebox whereby initiating the update module of Martin et al. to download the required songs (figure 4a and 4b).

Further, the prior art is silent regarding the disclosure for a random selection of the musical recording for use in the game from the customized library. It could be interpreted that the game operators of the prior art can be said to have randomly selected the musical recordings from the game library. However, in a related patent, Winsky discloses a musical trivia game wherein musical recordings are stored onto memory of a controller and the recordings may be randomly selected for use in the trivia game. Therefore it would be obvious to one of ordinary skill in the art at the time of applicant's invention to implement the random musical selection of Winsky in order to introduce variety into the game so players are offered different game scheme each time the game is played as oppose to being offered the same questions and answers which makes subsequent play of the game undesirable.

Regarding claims 16-18, Johnny Rockets Name That Tune teaches that as discussed above regarding Claims 12, 15, and 19. Johnny Rockets Name That Tune seems to lack explicitly disclosing a ranking system to rank player' performance.

Tom & Liz's Name That Tune, like Johnny Rockets Name That Tune is a computer/network-based name that tune game. Tom & Liz's Name That Tune shows:

Regarding Claim 16:

Art Unit: 3714

- collecting game performance information for a plurality of different users and ranks the users according to their performance (pp. 4 and 5 of 10).

Regarding Claim 17:

- send user-ranking information to the terminal, and the terminal is operable to display ranking information.

Regarding Claim 18:

- the system includes a plurality of said terminals (each player's personal computer having an Internet connection) at different locations (players live in a plurality of states), each of the terminals being operable to communicate with the server, and further wherein the server is operable to collect performance information on users who play the game at any of the terminals to send user ranking information to each of the terminals.

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate the player performance ranking system of Tom & Liz's Name That Tune game in Johnny Rocket's Name That Tune game and Martin et al. Providing a display of player rankings for games or game tournaments is notoriously well known to one of ordinary skill in the gaming art. Doing so motivates a game player to perform well and enables players to size up the competition.

The prior art is silent regarding the means of collecting and distributing user-ranking data via a server. As applicant has stated it leaves the possibility for a server or a person reading emails to collect and rank user performance. However it is notoriously well known in the art to utilize a server to collect individual game

Art Unit: 3714

performance data and distribute such data according to the teachings of Tom and Liz's Name That Tune. Furthermore, it would have been obvious to one of ordinary skill in the art to include a server for automatic data collection and distribution of the results, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. One would be motivated to make such a modification in order to eliminate the need for an operator whereby reducing operating costs for system owners.

Regarding claims 20-23, Winsky teaches a musical trivia game wherein the game is further operable to randomly select a question about the selected recording from a list of predetermined questions (Winsky 8:20-30). The randomly generated questions are based on the recording and stored on the system. Winsky also teaches that only a random portion of the entire recording may be played back (7:28-54). Regarding claim 23, wherein the system is further operable to select a portion of the selected recording for playback to a user based on at least one predetermined criteria, the predetermined criteria can be that the recording must be on the system. Therefore it would have been obvious to one of ordinary skill at the time of invention to include the random question types of Winsky and the random portion of the recording to play back in order to increase the difficulty of the game whereby players must be able to recognize the a song from a small bit of recording as well as be able to answer random trivia questions about the song and not just the song title.

Response to Arguments

Applicant's arguments filed 07/12/2007 have been fully considered but they are not persuasive.

Applicant alleges that the prior art does not meet the claimed limitations in that the prior art fails to teach or suggest a module operable to automatically control, for the needs of the game, the updating of the customized libraries of musical recordings stored in a jukebox system. The examiner respectfully disagrees. Martin et al. teaches a module operable to automatically control the update of the songs on a jukebox system as needed (figure 4a and 4b, emphasis added to feature 107, column 6). Regarding the language of "for the needs of a game," the examiner has interpreted the language to be intended use in which the module of Martin et al. is certainly capable of especially when combined with the game of Tom and Liz's Name That Tune, which requires the songs to be played in order for participation of the game. When combined, it would be obvious and routine to one of ordinary skill in the art that the module of Martin et al. must also download songs that are required by the game in order for the game to work or else the player cannot participate in the game which requires that the player listen to the song as discussed in detail above.

The arguments drawn towards the system ranking is moot in view of the new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dat T. Nguyen whose telephone number is (571) 272-2178. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dat Nguyen


ROBERT E. PEZZUTO
SUPERVISORY PRIMARY EXAMINER